

REMARKS

These remarks are in response to the Office Action dated November 26, 2007. Claims 1-51 are currently pending in the application. Claims 1-51 stand rejected. Applicant has amended no claims, and respectfully requests reconsideration of the application as presented herein.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on European Pat. App. EP 1 024 661 A2 to Gagnon et al. and U.S. Patent No. 6,310,661 to Arsenault

Claims 1-7, 9-16, 18-20, 22-27, 29-36, 39-44, and 46-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over by European Patent No. EP 1 024 661 A2 to Gagnon et al. (“Gagnon”) in view of U.S. Patent No. 6,310,661 to Arsenault (“Arsenault”). Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, the Examiner must determine whether there is “***an apparent reason to combine*** the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Further, rejections on obviousness grounds “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id* at 1741, quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, ***the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure.*** *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 1-7, 9-16, 18-20, 22-27, 29-36, 39-44, and 46-50 are improper because the elements for a *prima facie* case of obviousness are

not met. Specifically, there is no apparent reason to combine the known elements in the fashion claimed by the patent at issue as is required for a proper obviousness rejection under 35 U.S.C. §103.

As respectfully notes, Applicant's invention as presently claimed recites, in part, *"information [] including physical channel parameters"*, which is not taught or suggested in any proper combination in Gagnon and Arsenault. Applicant respectfully submits that Gagnon and Arsenault in any proper combination does not teach or suggest either *"transmitting broadcast overhead information/message ... on the broadcast transmission channel"* or *"information including physical channel parameters to a receiver [] for processing [a] broadcast channel/session"* as claimed in Applicant's independent claims 1, 3, 5, 7, 12, 23, 39, and 47 or *"determining an information [] including physical channel parameters"* and *"processing the broadcast stream in accordance with the determined information"* as claimed in Applicant's independent claims 19 and 34.

The Office Action alleges:

... Gagnon et al. does not specifically disclose the information including physical channel parameters.

With respect to claims 1, 3, 5, 7, 12, 19, 23, 34, 39, and 47, Arsenault, in the field of communications discloses adding physical channel parameters to broadcast information (See column 11 lines 36-50 of Arsenault for reference to *controlling data streams broadcast from satellites including* information specifying the Frequency, polarization, and orbit location, which are *all types of physical channel parameters*, where a program can be found and for reference to a receiving apparatus using this information to process a broadcast session). *Adding physical channel parameters to broadcast information has the advantage of allowing a receiver to automatically tune and align its antennas with satellite signals in order to avoid the potential for human error* (See column 11 lines 36-50 of Arsenault for refer to this advantage).

It would have been obvious for one of ordinary skill in the art at the time of the invention, when presented with the work of Arsenault, to *combine adding physical channel parameters to broadcast information, as disclosed by Arsenault, with the system and method of Gagnon et al., with the motivation being to allow a receiver to automatically tune and align its antennas with satellite signals in order to avoid the potential for human error.* (Office Action, pp. 11-12; emphasis added).

Applicant respectfully asserts that there *must be an apparent reason to combine* the known elements in the fashion claimed by the patent at issue. In the present combination, not only is there no apparent reason to combine the references, *there is an apparent reason to not*

combine the references as alleged. Applicant respectfully asserts that the alleged combination of Arsenault's "information including physical parameters" into Gagnon would result in an undesirable and inefficient inclusion of superfluous "physical channel parameters" in a broadcast transmission since Gagnon's satellite-based television system already includes the physical channel parameters within the tuner. Accordingly, Gagnon would have no need for Arsenault's alleged "**information [] including physical channel parameters**" since Gagnon's SDP record is a programming guide that is **consumed by the user** for making available programming selections and "**the receiver station 106 properly tunes itself to receive the selected information**".

Specifically, Gagnon actually teaches:

Although a variety of data processing techniques could be used in conjunction with the PPG of the present invention, BFD, BARP, and SDP + are exemplary of preferred data processing methods. Respectively, these methods provide a way of reliably transferring file data in a one-way communication channel, resolving IP addresses into physical addresses, and **announcing to the receiver station 106 how to display available data streams for selection, and when and how to tune to data streams selected by the user.** (Gagnon, col. 23, lines 25-35; emphasis added.)

The system user (client) uses SDP + records to schedule program reception. After the **client makes selections** based on the SDP + record information, **the receiver station 106 properly tunes itself to receive the selected information.** (Gagnon, col. 30, lines 43-47; emphasis added.)

Therefore, including Arsenault's superfluous "physical channel parameters" in Gagnon's programming guide would render Gagnon to be far more inefficient by consuming precious transmission bandwidth for transmitting the *combined* the unnecessary information. Accordingly, there is **no apparent reason to combine** the known elements in the fashion claimed by the patent at issue as is required for a prima facie case of obviousness. Additionally, "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teaching of the prior art so that the claimed invention is rendered obvious, . . . [o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fritch, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Therefore, Applicant respectfully requests the rejections be withdrawn.

Furthermore, the alleged *combination* does not result in Applicant's invention as claimed since placing Arsenault's "physical channel parameters" into Gagnon's SDP record would result

in the “physical channel parameters” being processed by Gagnon to be included as part of the programming guide for presentation to a user. Exactly how the “receiver station 106 properly tunes itself to receive the selected information” is not further described in Gagnon, however, Gagnon is abundantly clear that the “client makes selections based on the SDP + record information” and the “user (client) uses SDP + records to schedule program reception”. Clearly, Gagnon only teaches of handling the SDP record for presentation of data (e.g., programming guide) to a user and not for utilization of “physical channel parameters” for processing the broadcast session as claimed by Applicant. Therefore, Applicant respectfully requests the rejections be withdrawn.

Furthermore, the Office Action’s proffered reasoning for motivation to combine, namely, the “*motivation being to allow a receiver to automatically tune and align its antennas with satellite signals in order to avoid the potential for human error*” finds no basis in Applicant’s invention as claimed. Specifically, Applicant does not claim or even disclose an interest or motivation for a “*receiver to automatically tune and align its antennas with satellite signals*” as alleged. Such *motivation* is based solely within the motivation for the invention of Arsenault and not Applicant’s invention as claimed. Therefore, the rejection is further defective for this reason. Accordingly, Applicant respectfully requests the rejections be withdrawn.

Therefore, since there not only is no apparent reason to combine the known elements in the fashion claimed by the patent at issue, but there is a disincentive to combine the cited references, these references cannot render obvious, under 35 U.S.C. § 130, Applicant’s invention as presently claimed in independent claims 1, 3, 5, 7, 12, 19, 23, 34, 39, 47 and claims 2, 4, 6, 9-11, 13-16, 18, 20, 22, 24-27, 29-33, 35, 36, 40-44, 46, 48-50 depending variously therefrom. Accordingly, Applicant respectfully requests the rejections be withdrawn.

Obviousness Rejection Based on Gagnon in view of Arsenault and further in view of U.S. Patent No. 6,032,197 to Birdwell et al.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gagnon in view of Arsenault and further in view of U.S. Patent No. 6,032,197 to Birdwell et al. (“Birdwell”). Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of independent claim 7 precludes a rejection of claim 8 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to independent claim 7 and claim 8 which depends therefrom.

Obviousness Rejection Based on Gagnon in view of Arsenault and further in view of European Pat. No. EP1024661A2 to Rustad et al.

Claims 17, 28, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gagnon in view of Arsenault and further in view of U.S. Patent No. 6,775,303 to Rustad et al. ("Rustad"). Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of independent claims 12, 23, 39 preclude a rejection of claims 17, 28, 45 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to independent claims 12, 23, 39 and claim 17, 28, 45 which depend therefrom.

Obviousness Rejection Based on Gagnon in view of Arsenault and further in view of U.S. Patent No. 6,580,756 to Matsui et al.

Claims 21, 37-38, and 51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gagnon in view of Arsenault and further in view of U.S. Patent No. 6,580,756 to Matsui et al. ("Matsui"). Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of independent claims 19, 34, 47 preclude a rejection of claims 21, 37-38, and 51 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the rejection to independent claims 19, 34, 47 and claim 21, 37-38, and 51 which depend therefrom.

CONCLUSION

Claims 1-51 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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By: /Roberta A. Young/
Roberta A. Young, Reg. No. 53,818
(858) 651-5803

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121
Telephone: (858) 658-5787
Facsimile: (858) 658-2502